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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92062182
Party	Defendant PAC-WEST DISTRIBUTING NV LLC
Correspondence Address	PAC-WEST DISTRIBUTING NV LLC 848 N RAINBOW BLVD #5307 LAS VEGAS, NV 89107 UNITED STATES
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Mark Borghese
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Signature	/MB/
Date	10/09/2015
Attachments	2015-10-9-Motion to Dismiss.pdf(99978 bytes)

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AFAB INDUSTRIAL SERVICES, INC.,)	
)	
)	Cancellation No: 92062182
Petitioner,)	Registration No. 4,187,497
)	Marl: PWD
vs.)	
)	Registration No. 1,112,095
PAC-WEST DISTRIBUTING NV LLC)	Registration No. 4,541,507
)	Mark: RUSH
)	
Registrant.)	Registration No. 2,538,037
)	Mark: POWER PAK PELLET
)	

REGISTRANT’S MOTION TO DISMISS FOR INSUFFICIENT SERVICE

Pursuant to Rule 12(b)(5) of the Federal Rules of Civil Procedure and Trademark Rules of Practice 2.111, 2.126, and 2.127, Registrant, Pac-West Distributing NV LLC (“Pac-West”) hereby moves to dismiss the Petition to Cancel by AFAB Industrial Services, Inc., a Pennsylvania Corporation (“Petitioner”).

Pac-West is the owner, by assignment, of the registrations at issue in this proceeding, Registration Nos. 4187497, 1112095, 4541507 and 2538037 (the “Registrations”). Because Petitioner failed to serve a copy of its Petition to Cancel (the “Petition”) on Pac-West, as expressly required by the Trademark Rules of Practice and precedent established by the Trademark Trial and Appeal Board (the “Board”), the cancellation proceeding has not been properly instituted and should be dismissed. Pursuant to Trademark Rule 2.116(a), a party may raise the defense of insufficient service of process under Fed. R. Civ. P. 12(b)(5). *See Chocoladefabriken Lindt & Sprungli AG*, Opp. No 91187963, 91 U.S.P.Q.2D 1698 (T.T.A.B. July 30, 2009). Rule 12(b) allows the affirmative defense of insufficient service to be presented by motion to be filed prior to, or concurrently with, the defendant’s answer. *Id.*

I. STATEMENT OF FACTS

On September 1, 2015, Petitioner, acting through its attorney of record, filed the Petition to Cancel. The Certificate of Service at the end of the Petition states:

I, Sean P. McConnell, hereby certify that a true and correct copy of the foregoing Petition to Cancel has been served by U.S. First Class Mail, postage prepaid, and Email to:

Eric T. Fingerhut, Esquire
DYKEMA GOSSETT PLLC
1300 I Street NW, Suite 300
Washington, D.C. 20005-3314
jpmail@dykema.com

-and-

Mark Borghese, Esq.
BORGHESE LEGAL, LTD.
10161 Park Run Drive, Suite 150
Las Vegas, Nevada 89145
mark@borgheselegal.com

*Counsel for Respondent,
Pac-West Distributing NV LLC*

The electronic signature of Petitioner's counsel appears below that statement. Eric T. Fingerhut was the counsel of record for the three of the four original trademark applications filed by unrelated companies and has never represented Pac-West. The undersigned, Mark Borghese, has represented Pac-West, but is not listed as counsel of record in the Trademark Status and Document Retrieval ("TSDR") system. Neither Mr. Fingerhut nor Mr. Borghese are Domestic Representatives for the Registrations. In fact, no Domestic Representative has been appointed for the Registrations.

Pac-West Distributing NV LLC is a Nevada limited liability company with an address on

record with the United States Patent and Trademark Office as 848 N. Rainbow Blvd #5307, Las Vegas, NV 89107. Pac-West never received a service copy of the Petition at its address of record.

II. ARGUMENT

Petitioner failed to properly serve the Petition and accordingly, the cancellation proceeding should be dismissed. Trademark Rule of Practice 2.111(b) provides that,

. . . Petitioner must serve a copy of the petition, including any exhibits, on the owner of record for the registration, or on the owner's domestic representative of record, if one has been appointed, at the correspondence address of record in the Office. The petitioner must include with a petition for cancellation proof of service, pursuant to Sec. 2.119, on the owner of record, or on the owner's domestic representative of record, if one has been appointed, at the correspondence address of record in the Office.

37 C.F.R. 2.111(b) (*emphasis added*).

Here Petitioner failed to serve Pac-West at its address of record, and no Domestic Representative has been appointed. Affixing proof of service to a petition for cancellation without actually effecting service in accordance with the rules is insufficient to commence the proceeding. *See Springfield Inc. v. XD*, 86 USPQ2d 1063, 1064 (TTAB 2008); *see also, See Schott AG v. L'Wren Scott*, 88 USPQ2d 1862 (TTAB 2008).

Moreover, service on an attorney -- even an attorney of record -- is insufficient service unless the attorney is also listed as a Domestic Representative. *See Jacques Moret, Inc. v. Speedo Holdings B.V.*, 102 U.S.P.Q.2D 1212 (T.T.A.B. 2012) (“[w]here the Office records for a registration indicate the existence of an attorney of record, but said attorney is not also designated as domestic representative for the registration, service of a petition for cancellation on said attorney is insufficient.”). Thus, a cancellation proceeding has not been instituted if a copy of the petition is not served on the owner of the mark in question, or its domestic representative, at the correspondence address of records listed in the Office records.

In this case the TSDR system lists Pac-West as the owner of the Registrations with an

address of record as 848 N. Rainbow Blvd #5307, Las Vegas, NV 89107 and indicates that Pac-West has not appointed a domestic representative. The Certificate of Service attached to the Petition did not indicate service to Pac-West nor did Pac-West receive the Petition from the Petitioner at its address of record.

Service of courtesy copies of the Petition on Mr. Fingerhut and Mr. Borghese – neither of whom were ever appointed Pac-West’s domestic representative for the Registrations - does not comply with the straightforward rule for service set forth in Trademark Rule 2.111.

Accordingly, the Petition was not properly served and the cancellation proceeding should be dismissed.

III. CONCLUSION

For the foregoing reasons, Registrant respectfully requests the Board to exercise its authority under Rule 12(b)(5) and dismiss the cancellation proceeding against Pac-West for improper service.

Respectfully submitted,

Dated: October 9, 2015

By: 

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Las Vegas, Nevada 89145
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Email: mark@borgheselegal.com

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **REGISTRANT'S MOTION TO DISMISS FOR INSUFFICIENT SERVICE** has been served on the attorney of record for Petitioner on October 9, 2015 by U.S. First Class Mail, postage prepaid to:

Sean P. McConnell
PEPPER HAMILTON LLP
3000 Two Logan Square Eighteenth and Arch Streets
Philadelphia, PA 19103-2799



Mark Borghese